

Remarks

1. Summary of Office Action

a. Specification

The Examiner objected to the disclosure because page 6, line 12 reads, “U.S. Application No. 09/951,351” should be updated to “U.S. Patent No. 6,798,769 B1.” In addition, page 12, line 2 contains “in made”, but should be changed to “is made.”

b. Claim Objections

The Examiner objected to claims 4-6, 9-10, and 17-19. In claim 4, lines 10-11 contain the words “setoff” and “OAMEOC”, but should rather contain “set off” and “OAM/EOC”. In claim 9, lines 5 and 11 contain “interface between” and “of downstream”, but should rather contain “interface coupled between” and “of N downstream”, respectively.

In addition, the Examiner objected to claim 19 because lines 9-10 contain “a DSL Modem data, otherwise if connected to an OAM/EOC Modem, transferring synchronization data;” but should rather contain “one of the group of M DSL modems;”. The Examiner also rejected lines 11-12 because they both contain the language “transferring synchronization data if the Customer Premise Equipment device is connected to an OAM/EOC Modem;” but should rather contain “(c) transferring synchronization data for the Customer Premise Equipment device if the Customer Premise Equipment device is connected to the OAM/EOC modem;”. In addition, line 15 was rejected because it contains “a DSL Modem” but should rather contain “one of the group of M DSL modems”. Line 16 should be changed from “a Time-Out” to “the time-out”, and in line 17 “(a)-(e)” and “(b)-(e)” should be “(a)-(d)” and “(b)-(d)”, respectively.

Furthermore, the Examiner suggested that Applicant change “Customer Premise Equipment”, “Time-Out or No-More-Data”, “Public Switched Telephone Network”, and “Modem” to lower case.

c. Claim Rejections

The Examiner rejected claims 9-10 and 16-19 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. In addition, the Examiner rejected claims 3-10 and 16-19 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards the invention.

The Examiner provisionally rejected claims 3-4 and 6 under the judicially created doctrine of double patenting over claims 1-2 and 4 of co-pending Application No. 10/159,496.

The Examiner also rejected claims 3 and 7-8 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,804,267 B1 (Long), and claims 4-5, 9-10, and 16-18 under 35 U.S.C. § 103(a) as being obvious over a combination of Long and U.S. Patent No. 6,798,769 B1 (Farmwald).

2. Status of Application

As shown above, Applicant has amended the disclosure to correct typographical errors that were pointed out by the Examiner and to update the referenced patent application number. In addition, Applicant has cancelled claims 1-2, 4, and 11-15, amended claims 5-6, 8-9, and 19 to correct for typographical errors, and added claims 20-22. Furthermore, Applicant has amended claims 3 and 9 to further specify the claimed

subject matter and also to render them enabling. See Specification page 5, lines 4-7; page 9, lines 23-27.

Now pending in this application are claims 3, 5-10, and 16-22, of which claims 3 and 9 are independent, and the rest are dependent.

Applicant's invention teaches a method of oversubscribing DSL modems, such that M DSL modems provide DSL service to N CPE devices, where $M < N$. M DSL modems and P OAM/EOC modems located upstream in a DSLAM are connected to N downstream customer premise equipment devices, where $M + P = N$, and $P \geq 1$. The M DSL modems are connected to M CPE devices, such that the M CPE devices are provided with full data rate transmission to enable the transfer of user traffic data. The remaining P CPE devices are connected to P OAM/EOC modems, which transmit low bandwidth synchronization data to keep the CPE devices in a state as if they were connected to DSL modems.

Upon a transition condition, Applicant's invention dynamically reconfigures the DSL modem and OAM/EOC modem upstream connections to the downstream CPE devices. In this event, at least one of the set of M CPE devices is connected to one of the group of P OAM/EOC modems such that it remains in a state as if the CPE device was connected to a DSL modem. In addition, at least one of the set of P CPE devices is connected to one of the group of M DSL modems such that it is enabled to receive user traffic data. In this manner, N CPE devices are provided DSL service by M DSL modems on a dynamic basis.

3. Response to Rejections

a. Double Patenting Rejection

The Examiner provisionally rejected claims 3 and 6 under the judicially created doctrine of double patenting over claims 1-2 and 4 of co-pending Application No. 10/159,496. Applicant has amended claim 3 so as to add a new limitation that is not found in the claims of the cited application. Because claim 6 depends upon claim 3, claim 6 also contains this new limitation as well.

Because Applicants have added a new limitation to claim 3, Applicants respectfully traverse the double patenting rejection to claims 3 and 6.

b. Response to 35 U.S.C. § 102(e) Rejection of Claims 3 and 7-8

The Examiner rejected claims 3 and 7-8 under 35 U.S.C. § 102(e) as being anticipated by Long. For a proper rejection under 35 U.S.C. § 102(e), a cited reference must disclose each and every limitation of the rejected claim. *See* M.P.E.P § 2131. Applicant respectfully traverses the rejection because as amended, Long does not teach each and every limitation of claim 3. Namely, Long does not teach a method of dynamically reconfiguring the CPE connections to the upstream modems.

Long describes a method for adding new DSL systems to existing TCM ISDN services in a common cable bundle so that high bandwidth rates can be achieved without cross talk interference. Col. 4, lines 8-15. Long achieves higher data rates while reducing cross talk interference by synchronizing the new DSL system, the existing ISDN system, and the downstream CPE devices through a common burst clock.

However, Long fails to disclose a method of dynamically reconfiguring the downstream CPE connections to the upstream modems. In Applicant's invention, claim 3 as amended contains the element of dynamically reconfiguring the M DSL and P OAC/EOC modem connections to the CPE devices. In Long, the connections between

the upstream DSL and ISDN modems to the downstream CPE devices remain fixed. Thus, Long fails to disclose a method of dynamically reconfiguring the CPE device connections to the upstream modems.

Therefore, Long fails to teach or disclose each and every element of claim 3. As such, Applicant respectfully submits claim 3 is in a condition for allowance. In addition, claims 7-8 depend from and therefore include all of the limitations of claim 3, Applicant respectfully submits claims 7-8 are in a condition for allowance as well.

c. Response to 35 U.S.C. § 103(a) Rejection of Claims 4-5, 9-10, and 16-18

The Examiner rejected claims 5, 9-10, and 16-18 under 35 U.S.C. § 103(a) as being obvious over a combination of Long and Farmwald. Applicant respectfully traverses the rejection of the claims because Farmwald is disqualified as prior art under 35 U.S.C. § 103(a) through common ownership. As Farmwald is disqualified as prior art, Long cannot be combined with Farmwald to establish a valid 35 U.S.C. 103(a) rejection. See MPEP § 706.02(1)(2).

Farmwald is disqualified as prior art under 35 U.S.C. 103(a) through common ownership of Applicant's invention and Farmwald by Pedestal Networks, Inc. Under M.P.E.P. § 706.02(1), in order to be disqualified as prior art under 35 U.S.C. 103(a), the subject matter which would otherwise be prior art to the claimed invention and the claimed invention must be commonly owned at the time the claimed invention was made, or subject to an obligation of assignment that would establish common ownership. See MPEP § 706.02(1). Applicant's invention and Farmwald were, at the time the invention of Applicant was made, owned by Pedestal Networks, Inc. Subsequently, Pedestal Networks Inc. assigned its interest in both of the applications to UTStarcom, Inc., which

is currently the common owner. Applicant further submits objective evidence of the reference of assignments recorded in the U.S. Patent and Trademark Office in accordance with 37 CFR Part 3, which shows the conveyance of the entire rights of Applicant's invention and Farmwald to Pedestal Networks, Inc., which were both subsequently conveyed to UTStarcom, Inc. Because Applicant's invention and Farmwald are subject to common ownership, Farmwald is disqualified as prior art under 35 U.S.C. § 103(a).

Since Farmwald is disqualified as prior art under 35 U.S.C. § 103(a) through common ownership, Long therefore cannot be combined with Farmwald to establish a valid 35 U.S.C. § 103(a) rejection. As such, Applicant respectfully submits that claims 5, 9-10, and 16-18 are in a condition for allowance. Favorable reconsideration is requested.

4. Conclusion

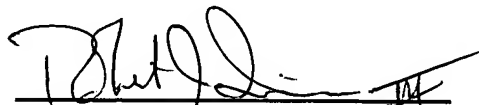
For the foregoing reasons, Applicant submits that all of the pending claims are now in condition for allowance. Applicant thus respectfully requests favorable reconsideration and allowance.

Respectfully submitted,

**McDONNELL BOEHNEN
HULBERT & BERGHOFF LLP**

Date: October 19, 2005

By:


Robert J. Irvine
Reg. No. 41,865